

REMARKS

STATUS OF THE CLAIMS

Claims 1-43 and 45-60 are pending in this application. Claims 20-25 and 48-60 have been withdrawn by the Office as being directed to non-elected subject matter. Claims 1-19 and 26-46 are rejected, and claim 47 is objected to.

Claims 1, 4, 37, 39, and 47 have been amended to replace the phrase "one or more than one" with the phrase "at least one." These amendments are supported by the claims and specification as originally filed. No new matter has been added.

DOUBLE PATENTING

Claims 1-19 and 26-57 were rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-15 of U.S. Patent No. 6,110,922 ("922 patent"). Office Action, page 4. Applicants' point out that the '922 patent is now in reissue as Application No. 10/356,794, filed August 29, 2002. Therefore, a terminal disclaimer is currently not applicable because the present application and the reissue application are currently co-pending. See M.P.E.P § 804(I)(B). Accordingly, Applicants request that this rejection be made provisional and held in abeyance until allowable subject matter is indicated in either this application or the reissue application.

Claims 1-19 and 26-57 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-19, 26-31, 34-45, and 47-57 of co-pending Application No. 09/695,040. *Id.*, page 5. Applicants request that this provisional rejection be held in abeyance until allowable subject matter is indicated.

The Office also states:

Claims 1-19 and 26-57 are directed to the same invention as that of claims 1-15 of commonly assigned U.S.P. 6110922. The issue of priority under 35 U.S.C. § 102(g) and possibly 35 U.S.C. § 102(f) of this single invention must be resolved. ... the assignee is required to state which entity is the prior inventor of the conflicting subject matter.

Id. Applicants traverse this requirement.

First, Applicants point out that the overlapping subject matter in the present application and in the '922 patent were both filed in the United States on the same date, December 29, 1998. The present application is a continuation-in-part of Application No. 09/474,517, filed December 29, 1999, which is a continuation-in-part of provisional Application No. 60/114,097, filed December 29, 1998. The '922 patent issued from Application No. 09/222,491, filed December 29, 1998.

Second, the same inventive entity provided the disclosure for both of the applications filed December 29, 1998, for this application and of that for the '922 patent.

Third, additional inventive subject matter was added to the original provisional application and filed in two subsequent non-provisional continuation-in-part applications, Application Nos. 09/474,517 and 09/541,795. Additional inventors were at least partially responsible for this additional new inventive subject matter. Applicants also note that all inventors on the '922 patent are listed as inventors on the present application.

Accordingly, because all overlapping claimed subject matter in the present application and in the '922 patent was disclosed by the same inventive entities in priority applications filed on the same date, December 29, 1998, the issue of priority under 35 U.S.C. § 102(g) or (f) is now resolved.

FAILURE TO COMPLY WITH 37 C.F.R. § 1.141(a)

Claims 12 and 13 are rejected for failure to comply with 37 C.F.R. § 1.141(a) as being more than a reasonable number of species. *Id.*, page 6. Applicants traverse the rejection.

In support of its rejection, the Office cites the directive of Richard A. Wahl, August 10, 1968. Applicants point out that the instant directive generally discusses species claims dependent upon a genus, and does not mention 37 C.F.R. § 1.141(a) or “a reasonable number of species”.

Applicants note that claim 1 is considered by the Examiner to be free of the art. Claims 12 and 13 depend from and are encompassed in scope by claim 1, and therefore would also be free of the art. Accordingly, Applicants submit that the number of species recited is not unreasonable, for at least the reason that the broad genus encompassing the species has already been searched for and considered to be free of the art.

Further, the search for, and consideration of, the subject matter of claims 12 and 13 is encompassed by that conducted for claim 1. Therefore, Applicants submit there is no additional burden on the Examiner regarding claims 12 and 13. Accordingly, the number of species in claims 12-13 is reasonable for the purposes of 37 C.F.R. § 1.141(a).

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

INDEFINITENESS REJECTIONS

Claims 1-19 and 26-57 have been rejected as allegedly indefinite under 35 U.S.C. § 112, second paragraph. Applicants traverse the rejections for the following reasons.

The Office alleges that in Claim 1 the use of "Ar" variables "l. Aminocarbonyl, [and] t. Carboxamide...is not very clear as to what the applicants want to claim as a substituent on a ring because a group: -CONH₂ = NH₂CO-." Applicants have amended the claims by deleting "l. Aminocarbonyl" from the definition of "Ar" for the compounds of formula (I) in claim 1. Applicants do not believe that this amendment narrows the scope of the claims.

The Office states that in Claim 1 "[i]t is not exactly clear as to what is meant by: 'more than one'. It can be 2 or infinite." *Id.* Applicants submit that one of ordinary skill would understand what the phrase "one or more than one" refers to in claim 1. Contrary to the Office's assertion, one of ordinary skill in the art would understand that an "infinite" number of substitutions would not be possible, and is not being taught or suggested by the claims and specification. Solely to promote the prosecution of the application, however, the Applicants have amended claims 1, 4, 37, 39, and 47 by replacing "one or more than one" with the phrase "at least one." Applicants do not believe that this amendment narrows the scope of the claims.

The Office appears to suggest that claims 19 and 47 recite duplicate pharmaceutical compositions, and that "[c]orrection is required to avoid duplication." *Id.* Applicants traverse the rejection by pointing out that claims 19 and 47 do not recite identical subject matter. MPEP § 706.03(k) notes that "court decisions have confirmed

applicant's right to restate (*i.e.*, by plural claiming) the invention in a reasonable number of ways. Indeed, a mere difference in scope between claims has been held to be enough." Claim 19, dependent on claim 1, includes the recitation of compounds of formula (I). Claim 47, on the other hand, does not recite formula (I). Therefore, claims 19 and 47 are not duplicates of one another. Accordingly, Applicants submit that claims 19 and 47 are not indefinite.

The Office alleges that the use of the term "about" as recited in claims 45 and 46 in the phrases "about 50 percent" and "about 100 percent" is indefinite. *Id.* Applicants traverse the rejection. MPEP § 2173.05(b) notes that the use of the term "about" has been held to be clear and not indefinite when infringement of the claim could be clearly assessed. Applicants submit that potential infringement of the claims could be assessed, for example, by performing the assays recited in the claims and specification. Accordingly, Applicants submit that the phrases "about 50 percent" and "about 100 percent" as used in claims 45 and 46 are not indefinite.

The Office rejects claim 44 because the phrase "inhibitory activity" is allegedly indefinite. *Id.* Applicants traverse the rejection. Solely to promote the prosecution of the application, however, Applicants have canceled claim 44.

The last paragraph of page 7 and first full paragraph of page 8 of the Office Action discusses claims 47 and 54 in some detail. Applicants note that claim 54 has been withdrawn from consideration. It is unclear whether the Office is providing additional reasons for rejecting claims 47 or 54, and, if so, what the statutory bases for the rejections are. If claims 47 and 54 are rejected then Applicants respectfully request issuance of a new non-final Office Action detailing these rejections for the first time.

CLAIM OBJECTIONS

The Office states that “independent claim [37] is objected to because...Independent claim 37 does not define any structure or formula for the claimed diaryl sulfide cinnamide. This claim is a duplicate of main claim 1. Appropriate correction is required.” *Id.*, page 8. Applicants traverse the objection by pointing out that claims 1 and 37 are not duplicates of any other claim. Independent claim 1 recites compounds of formula (I). Independent claim 37, on the other hand, recites compounds not limited by formula (I). Therefore, claims 1 and 37 are not duplicates of one another. Moreover, contrary to the Office’s assertion, Applicants submit that claim 37 does define a structure for the claimed diaryl sulfide cinnamide compound. Accordingly, Applicants respectfully request reconsideration and withdrawal of these claim objections.

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CONCLUSION

Applicants respectfully request entry of the amendments, reconsideration of this application, withdrawal of the noted rejections and objections, and an indication of allowable subject matter.

If the Examiner believes a telephone conference would help resolve any remaining issues, the Examiner is invited to contact the undersigned at (202) 408-4128.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: 

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